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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/805,149

03/19/2004

Rod Reese

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EXAMINER

FUELLING, MICHAEL

ART UNIT

PAPER NUMBER

4135

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/805,149	Applicant(s) REESE, ROD	
	Examiner MICHAEL FUELLING	Art Unit 4135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 31-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 31-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>March 19, 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a non-final, first office action on the merits for the above-identified divisional application of 10/172,391 (US Patent No. 6, 711,460) filed March 19, 2004, which claims priority to US Provisional Application 60/299,116 filed June 18, 2001. Claims 1 and 31-77 are pending.

Claim Objections

2. Claim 59 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 59 does not include all of the elements of claims 1, 31-33, 36, 37, 41, 42 and 49 from which claim 59 depends.

One way to correct this defect would be to delete the phrase "the pharmacy comprises a customer terminal, and wherein" from claim 59.

3. Claims 1 and 31-77 are objected to because of the following informalities. Appropriate corrections are required.

In claim 1, line 7, it appears "item" should be inserted before "handling." In claim 1, line 10, it appears "by be" should be corrected to "by and." Claims 31-77 depend from claim 1 and have the same defects as claim 1.

In claim 52, line 1, it appears "further" should be inserted before "includes." Claims 53 and 54 depend from claim 52 and have the same defect as claim 52.

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In claim 57, it appears “the prescription input device” should be corrected to “the at least one prescription input device.”

In claim 58, it appears “the prescription input device” should be corrected to “the at least one prescription input device.”

In claim 59, it appears “the at least one input device” should be corrected to “the at least one prescription input device.”

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 70 and 73-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 recites “further comprising [* * *] a pharmacist terminal” while claim 1 already recites “a pharmacist terminal.” So, it is unclear if claim 1 and claim 70 are referring to the same pharmacist interface which is distant from the location where the robot and the prescription input device of claim 1 are placed. Claims 73-77 depend from claim 70 and have the same defect as claim 70.

One way to overcome these defects would be to delete the phrase “; a pharmacist terminal” from lines 2 and 3 in claim 70.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 and 31-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to nonstatutory subject matter.

Claim 1 recites "Apparatus comprising: a pharmacy including: [* * *]." A pharmacy does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 as a pharmacy is not a process, machine, manufacture, or composition of matter.

Additionally, applicant's claimed invention encompasses people. If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made. MPEP 2105

Applicant's specification at page 5, lines 17-18 describes an exemplary embodiment of applicant's pharmacy as including a "remote pharmacist."

Claims 31-77 depend from claim 1 and have the same defect as claim 1.

One way to overcome these defects would be to delete the phrase "a pharmacy including:" in line 2 of claim 1, and in lines 4 and 9 of that claim, change "the pharmacy" to something like "a location" and "the location," respectively. Similarly, in claims 31, 33, 36, 37, 41-43, 49, 52 and 64, the phrase "wherein the pharmacy" could be changed to something like "which."

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1 and 46 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13 and 14 of Reese, U.S. Patent No. 6,711,460 B1 ('460). Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 13 of '460 for a method comprises:

i) receiving a prescription for medication at a pharmacy;

ii) electronically transmitting the prescription to a pharmacist remotely

located from the pharmacy where the prescription is received and

iii) preparing the medication at the pharmacy responsive to directions

given from a pharmacist remote from the pharmacy, wherein the remote

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pharmacist fills the prescription by controlling a robot at the pharmacy where the prescription was received.

Claim 1 of the pending divisional application for an apparatus comprises:

- i) x) a prescription input device and y) a robot at one location and
- ii) a pharmacist interface at a location faraway from the first location,

wherein the interface can receive prescription information from the device and operate the robot to fill a prescription according to direction from a pharmacist at the faraway location.

The sole difference between claim 13 of '460 and pending claim 1 is that pending claim 1 expressly includes a prescription input device. It would have been obvious to one of ordinary skill in the art at the time of the invention that some kind of data input device is needed to perform the method of claim 13 of '460 as such device is needed for "electronically" transmitting the prescription to the remote pharmacist.

Claim 14 of '460 for a method comprises:

- i) receiving a prescription for medication at a pharmacy;
- ii) electronically transmitting the prescription to a pharmacist remotely located from the pharmacy where the prescription is received and
- iii) preparing the medication at the pharmacy responsive to directions given from a pharmacist remote from the pharmacy, wherein the remote pharmacist fills the prescription by controlling x) a drug retrieval robot and y) a compounding robot at the pharmacy where the prescription was received.

Claim 46 of the pending divisional application for an apparatus comprises:

- i) a prescription input device;
- ii) a robot in a drug retrieval area;
- iii) a robot in a compounding area and

iv) a pharmacist interface at a location faraway from the input device and robots, wherein the interface can receive prescription information from the device and operate the robots to fill a prescription according to direction from a pharmacist at the faraway location.

The sole differences between claim 14 of '460 and pending claim 46 is that pending claim 46 expressly includes a prescription input device and placing the two robots in two separate areas. It would have been obvious to one of ordinary skill in the art at the time of the invention that some kind of data input device is needed to perform the method of claim 14 of '460 as such device is needed for "electronically" transmitting the prescription to the remote pharmacist. It also would have been obvious to one of ordinary skill in the art at the time of the invention to place the drug retrieval and compounding robots in separate areas.

Allowable Subject Matter

10. Claims 1 and 31-77 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and 35 U.S.C. 101 set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL FUELLING whose telephone number is (571)270-1367. The examiner can normally be reached on Monday - Thursday, 9 am - 5 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES REAGAN can be reached at (571)272-6710. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Beth V. Boswell/
Supervisory Patent Examiner, Art Unit 3623